

REMARKS

This is a full and timely response to the outstanding Advisory Action mailed March 13, 2006, as it relates to the Final Office Action mailed November 3, 2005. Upon entry of the amendments in this response, claims 21 – 38 remain pending. In particular, Applicants amend claims 21, 38, and 33. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Applicants first wish to express their sincere appreciation for the time that Examiner Manning spent with Applicants' Attorney, Anthony Bonner during a telephone discussion on January 6, 2006 regarding the outstanding Office Action. During that conversation, Mr. Bonner indicated that claim 21 is directed to subject matter different from that disclosed in the cited art. More specifically, Mr. Bonner indicated that the cited art does not appear to disclose "receive[ing] user input indicating the desired subset of content streams from the program event for recording." While no agreement was met, Applicants respectfully request that Examiner Manning carefully consider this response and the amendments.

II. Rejections Under 35 U.S.C. §102

A proper rejection of a claim under 35 U.S.C. §102 requires that a single cited art reference disclose each element of the claim. *See, e.g., W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

A. **Claim 21 is Patentable Over Lawler**

The Advisory Action and Office Action indicate that claim 21 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 5,805,763 (“*Lawler*”). Applicants respectfully traverse this rejection on the grounds that *Lawler* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 21, as amended, recites:

A selectable recording device for providing recording options to a user, comprising:
a storage device configured to store program information received from an input source, wherein the program information includes a plurality of content streams for a plurality of program events; and
a processor configured to:
provide a user option to ***select a desired subset of content streams for a particular program event for recording***, wherein the subset excludes at least one available content stream from the program event; and
receive user input ***indicating the desired subset of content streams from the program event for recording. (emphasis added)***

The Office Action states “[t]he claimed [step] of ‘provid[ing] a user option to select at least one desired subset of content streams of a particular program event for recording, wherein the subset excludes at least one available content stream’ ... [is] provided by Figure 5. The user chooses a program to record. By choosing a program to record, all other available content streams are excluded” (OA beginning p. 2, last line).

Applicants respectfully disagree with this analysis. FIG. 5 of *Lawler* includes a “go to show” button, a “record” button, and a “cancel” button. “Activation of the ‘record’ button, causes the interactive station controller to immediately activate the recording device 23 and control it to record the selected program. Alternatively, the interactive station controller could instruct a recording device at the head end to record and store the selective program” (*Lawler* col. 10, line 53). As illustrated in this excerpt, *Lawler* appears to disclose recording ***a program*** at the

recording device or, alternatively, recording *a program* at the headend. *Lawler*, however, fails to disclose, teach, or suggest a “selectable recording device for providing recording options to a user, comprising... a processor configured to: provide a user option to *select a desired subset of content streams for a particular program event for recording*, wherein the subset excludes at least one available content stream from the program event [and] receive user input *indicating the desired subset of content streams from the program event for recording*” as recited in claim 21, as amended. More specifically, nowhere in *Lawler* is there any option of recording any *subset of content streams for a particular program event*. As shown in FIGS. 5 and 6 (element 130) there is simply an option to record a program event, not “a user option to select at least one desired *subset of content streams for a particular program event* for recording” as recited in claim 21, as amended. For at least this reason, claim 21, as amended, is patentable over the cited art.

B. Claim 28 is Patentable Over *Lawler*

The Advisory Action and Office Action indicate that claim 28 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 5,805,763 (“*Lawler*”). Applicants respectfully traverse this rejection on the grounds that *Lawler* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 28, as amended recites:

A method for providing recording options to a user, comprising:
receiving program information, wherein the program information includes a plurality of content streams for a plurality of program events;
providing a user option to select a desired subset of content streams for a particular program event for recording, *wherein the subset excludes at least one available content stream from the program event*; and
receiving user input *indicating the desired subset of content streams from the program event for recording. (emphasis added)*

The Office Action states “[t]he claimed [step] of ‘provid[ing] a user option to select at least one desired subset of content streams of a particular program event for recording, wherein the subset excludes at least one available content stream’... [is] provided by Figure 5. The user chooses a program to record. By choosing a program to record, all other available content streams are excluded” (OA beginning p. 2, last line).

Applicants respectfully disagree with this analysis. FIG. 5 of *Lawler* includes a “go to show” button, a “record” button, and a “cancel” button. “Activation of the ‘record’ button, causes the interactive station controller to immediately activate the recording device 23 and control it to record the selected program. Alternatively, the interactive station controller could instruct a recording device at the head end to record and store the selective program” (*Lawler* col. 10, line 53). As illustrated in this excerpt, *Lawler* appears to disclose recording **a program** at the recording device or, alternatively, recording **a program** at the headend. *Lawler*, however, fails to disclose, teach, or suggest a “method for providing recording options to a user, comprising... providing a user option to select a desired subset of content streams for a particular program event for recording, *wherein the subset excludes at least one available content stream from the program event* [and] receiving user input *indicating the desired subset of content streams from the program event for recording*” as recited in claim 28, as amended. More specifically, nowhere in *Lawler* is there any option of recording any **subset of content streams for a particular program event**. As shown in FIGS. 5 and 6 (element 130) there is simply an option to record a program event, not “a user option to select at least one desired **subset of content streams for a particular program event** for recording” as recited in claim 28, as amended. For at least this reason, claim 28, as amended, is patentable over the cited art.

C. **Claim 33 is Patentable Over *Lawler***

The Advisory Action and Office Action indicate that claim 33 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 5,805,763 (“*Lawler*”). Applicants respectfully traverse this rejection on the grounds that *Lawler* does not disclose, teach, or suggest all of the claimed elements. More specifically, claim 33, as amended, recites:

A system for providing recording options to a user, comprising:
a receiver configured to receive program information from an input source, the program information including a plurality of content streams for a plurality of program events; and
a control system configured to:
provide a user option to select a desired subset of content streams for a particular program event, *wherein the subset excludes at least one available content stream from the program event*; and
receive a user command *indicating the desired subset of content streams from the program event for recording. (emphasis added)*

The Office Action states “[t]he claimed [step] of ‘provid[ing] a user option to select at least one desired subset of content streams of a particular program event for recording, wherein the subset excludes at least one available content stream’ ... [is] provided by Figure 5. The user chooses a program to record. By choosing a program to record, all other available content streams are excluded” (OA beginning p. 2, last line).

Applicants respectfully disagree with this analysis. FIG. 5 of *Lawler* includes a “go to show” button, a “record” button, and a “cancel” button. “Activation of the ‘record’ button, causes the interactive station controller to immediately activate the recording device 23 and control it to record the selected program. Alternatively, the interactive station controller could instruct a recording device at the head end to record and store the selective program” (*Lawler* col. 10, line 53). As illustrated in this excerpt, *Lawler* appears to disclose recording **a program** at the recording device or, alternatively, recording **a program** at the headend. *Lawler*, however, fails to

disclose, teach, or suggest a “system for providing recording options to a user, comprising ... provide a user option to select a desired subset of content streams for a particular program event, *wherein the subset excludes at least one available content stream from the program event* [and] receive a user command *indicating the desired subset of content streams from the program event for recording*” as recited in claim 33, as amended. More specifically, nowhere in *Lawler* is there any option of recording any *subset of content streams for a particular program event*. As shown in FIGS. 5 and 6 (element 130) there is simply an option to record a program event, not “a user option to select at least one desired *subset of content streams for a particular program event* for recording” as recited in claim 33, as amended. For at least this reason, claim 33, as amended, is patentable over the cited art.

D. Claims 22, 27, 29, 34, and 38 are Patentable Over *Lawler*

The Advisory Action and Office Action indicate that claims 22, 27, 29, 34, and 38 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent Number 5,805,763 (“*Lawler*”). Applicants respectfully traverse this rejection on the grounds that *Lawler* does not disclose, teach, or suggest all of the claimed elements. More specifically, dependent claims 22 and 27 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 21. Dependent claim 29 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 28. Dependent claims 34 and 38 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 33. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

III. Rejections Under 35 U.S.C. §103

In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the cited art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). Further, “[t]he PTO has the burden under section 103 to establish a prima facie case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

A. Claims 23, 30, and 35 are Patentable Over *Lawler* in View of *Shideleff*

The Advisory Action and Office Action indicate that claims 23, 30, and 35 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Lawler* in view of U.S. Patent Number 6,851,121 (“*Shideleff*”). Applicants respectfully traverse this rejection for at least the reason that *Lawler* in view of *Shideleff* fails to disclose, teach, or suggest all of the elements of claims 23, 30, and 35. More specifically, dependent claim 23 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 21. Dependent claim 30 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 28. Dependent claim 35 is believed to be allowable for at least the reason that this claim depends from allowable independent claim 33. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

B. Claims 24 – 26 and 31 – 32 are Patentable Over *Lawler*

The Advisory Action and Office Action indicate that claims 24 – 26 and 31 – 32 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Lawler*. Applicants respectfully traverse this rejection for at least the reason that *Lawler* fails to disclose, teach, or suggest all of the elements of claims 24 – 26 and 31 – 32. More specifically, dependent claims 24 – 26 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 21. Dependent claims 31 – 32 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 28. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

C. Claims 36 – 37 are Patentable Over *Lawler* in View of *Hoffberg*

The Advisory Action and Office Action indicate that claims 36 – 37 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Lawler* in view of U.S. Patent Number 6,418,424 (“*Hoffberg*”). Applicants respectfully traverse this rejection for at least the reason that *Lawler* in view of *Hoffberg* fails to disclose, teach, or suggest all of the elements of claims 36 – 37. More specifically, dependent claims 36 and 37 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 33. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

IV. Official Notice

A. Claim 24 is Not Well Known

In addition, with regard to claim 24, the Office Action states “[o]fficial notice is taken that it is notoriously well known in the art to encrypt a signal and offer a corresponding

decryption device so as to prevent signal theft while allowing authorized user access to the information carried on the signal.” (OA p. 5, last paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required.

Applicants additionally submit that particularly in the context of the claimed combination that includes “a user option to select a desired subset of content streams for a particular program event for recording,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and respectfully traverse the cited Official Notice.

B. Claim 25 is Not Well Known

In addition, with regard to claim 25, the Office Action states “[o]fficial notice is taken that it is notoriously well known in the art to [identify] a packet identifier and [parse] an MPEG table so as to obtain information about the stream.” (OA p. 6, first paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required.

Applicants additionally submit that particularly in the context of the claimed combination that includes “a user option to select a desired subset of content streams for a particular program event for recording,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and respectfully traverse the cited Official Notice.

C. Claim 26 is Not Well Known

In addition, with regard to claim 26, the Office Action states “[o]fficial notice is taken that it is notoriously well known in the art to [identify] a packet identifier and [parse] an MPEG table so as to obtain information about the stream.” (OA p. 6, first paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required.

Applicants additionally submit that particularly in the context of the claimed combination that includes “a user option to select a desired subset of content streams for a particular program event for recording,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and respectfully traverse the cited Official Notice.

D. Claim 31 is Not Well Known

In addition, with regard to claim 31, the Office Action states “[o]fficial notice is taken that it is notoriously well known in the art to encrypt a signal and offer a corresponding decryption device so as to prevent signal theft while allowing authorized user access to the information carried on the signal.” (OA p. 5, last paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required.

Applicants additionally submit that particularly in the context of the claimed combination that includes “a user option to select a desired subset of content streams for a particular program event for recording,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and respectfully traverse the cited Official Notice.

E. Claim 32 is Not Well Known

In addition, with regard to claim 32, the Office Action states “[o]fficial notice is taken that it is notoriously well known in the art to [identify] a packet identifier and [parse] an MPEG table so as to obtain information about the stream.” (OA p. 6, first paragraph). Applicants respectfully traverse the alleged finding of well known subject matter and submit that the subject

matter noted above should not be considered well known for at least the specific and particular reason that the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions, as required.

Applicants additionally submit that particularly in the context of the claimed combination that includes “a user option to select a desired subset of content streams for a particular program event for recording,” the subject matter in question is too complex for a reasonably skilled person to consider the subject matter well known to the point that no additional evidence is needed. For at least this additional specific and particular reason, Applicants respectfully submit that the subject matter in question is not well known in the art and respectfully traverse the cited Official Notice.


CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Advisory Action and/or Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Further, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known for at least the specific and particular reason that the Office Action (and/or Advisory Action) does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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